

REMARKS

The Notice of Non-Compliant Amendment dated February 4, 2010, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto. Specifically, Applicants have amended the status identifier for the withdrawn claims from "Withdrawn/Original" to "Withdrawn."

Applicants note that, claim 81 is incorrectly numbered as claim 80 in the claims listing filed on May 1, 2006. Applicants have amended the numbering of claims in this response to correct the above discrepancy. Applicants further note that claim 81 and not claim 80 reads on the elected species. Accordingly, claims 1, 36, 57-59, and 81 are rejected and claims 2-35, 37-56, 60-80, 82-90, and 92-98 are withdrawn from consideration.

Claims 1-98 were pending in the application. By this amendment, claims 1, 58, 81, 88 and 91 are amended and claims 36 and 57 are canceled. Accordingly, upon entry of this amendment, claims 1-35, 37-56, and 58-98 will be pending.

I. Claim Objections

Claims 1 and 36 are objected to because the claims do not end with a period. Applicants have amended claim 1 to overcome this objection. Claim 36 is canceled thereby rendering the objection to it moot. Claim 91 is objected to because of an improper language related to multiple dependency. Claim 91 is amended to properly recite multiple claims in the alternative to obviate this rejection.

II. Claim Rejection – 35 U.S.C. §103

Claims 1, 36, 57-59, and 81 are rejected under 35 U.S.C. §103(a) as being allegedly obvious over Garvey et al. (U.S. Patent No. 5,932,538, hereinafter “Garvey”).

The Examiner alleges that Garvey discloses that carvedilol can be modified to produce a nitrosated alpha-adrenergic receptor antagonist (Office Action, page 6). Applicants respectfully traverse this ground of rejection.

Applicants submit that Garvey fails to disclose or teach a nitrosating modification of carvedilol. In particular, Garvey discloses nitrosating modifications to formulae I-VII. However, none of these formulae are related to the same chemical class as carvedilol.

Furthermore, Garvey does not provide any motivation to select a 6-nitrosated hexanoic ester modification. Garvey discloses a large list of substituents for the position D in formulae I-VII (col. 6, line 21-38). For the position D disclosed in Garvey, the definition of substituent (iv), $-(CO)-T^1-[C(R_e)(R_f)]_p-T^2-Q$, will include a 6-nitrosated hexanoic ester only when T^1 is a covalent bond, R_e and R_f are hydrogen, p is equal to 5, T^2 is oxygen and Q is NO_2 . Only by simultaneously making each of these particular selections, is it possible to form a 6-nitrosated hexanoic ester of formulae I-VII. Accordingly, there is no teaching or suggestion in Garvey to make the multiple simultaneous selections required to obtain a 6-nitrosated ester. Furthermore, as discussed above, the teachings of Garvey are directed to formulae I-VII encompassing chemical classes entirely different from that of carvedilol. Thus, there is no teaching or motivation in the disclosure of Garvey to arrive at the presently claimed invention.

For at least the above reasons, Applicants submit that independent claim 1 is not obvious over Garvey. Because claims 58, 59, and 81 depend from claim 1, claims 58, 59, and 81 are also not obvious over Garvey. Claims 36 and 57 are canceled thereby rendering their rejection moot. In view of the above, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection of the presently claimed invention over Garvey.

III. Claim Rejections – 35 U.S.C. §112

Claims 1, 36, and 57-58 are rejected under 35 U.S.C. §112, first paragraph as being non-enabled. The Examiner alleges that because the amount and duration of NO released is determined by the structure of a compound, the rejected claims are not enabled for the full scope of the compounds claimed. Applicants have amended claim 1 to obviate this rejection. Claim 58 depends from claim 1. Claims 36 and 57 have been canceled. Thus, the rejection of claims 36 and 57 is moot.

Claims 1, 36, and 57-58 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. With respect to the recitation of “group capable of binding Y,” the Examiner takes the position that the term “binding” does not have a clear meaning in the art and is not defined in the Specification. Applicants have amended claims 1 to delete the recitation of “group capable of binding Y” to overcome this rejection. Claim 58 depends from claim 1. Claims 36 and 57 have been canceled thereby rendering their rejection moot.

Claims 1, 36, and 57-58 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. With respect to the recitation of formula (I) $A-(Y-ONO_2)_s$ wherein A has the structure of formula (II), the Examiner alleges that it is not clear which residues in the structure of "A" bond with the group $(Y-ONO_2)_s$. Applicants have amended claim 1 to recite that " $(Y-ONO_2)_s$ bonds with Z and/or Z1 of formula (II)" to overcome this rejection. Claim 58 depends from claim 1. Claims 36 and 57 have been canceled thereby rendering their rejection moot.

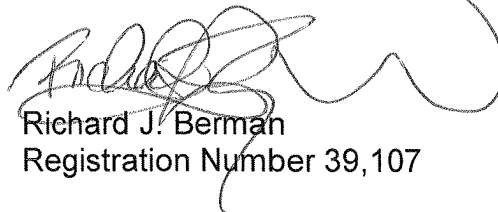
In view of the above amendments, applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §112 rejections of claims 1, 36, and 57-58.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance and such action is earnestly solicited. If the Examiner believes that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below to schedule a personal or telephone interview to discuss any remaining issues.

In the event this response is not timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension, along with any other additional fees which may be required with respect to this response, may be charged to Deposit Account No. 01-2300, referencing Attorney Docket No. **026220-00082**.

Respectfully submitted,



Richard J. Berman
Registration Number 39,107

Customer Number 04372
ARENT FOX LLP
1050 Connecticut Avenue, NW, Suite 400
Washington, DC 20036-5339
Telephone: 202-857-6000
Fax: 202-857-6395
RJB/TPJ:knc